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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,311	08/30/2000	David S. Soane	0225-0010.30	2715

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ACLARA BIOSCIENCES, INC.
1288 PEAR AVENUE
MOUNTAIN VIEW, CA 94043

EXAMINER

STARSIAK, JOHN S

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 09/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/651,311

Applicant(s) David S. Soane
Zoya M. Soane

Examiner
J. STARSIAK

Group Art Unit
1753

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10 July 2013
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 22, 23 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22, 23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites “a main arm” and “a plurality of side arms”. In the written description of the invention the terms “main arm” and “side arm” are not even used. MPEP 608.01 (o) states: “The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts to which the term applies. Claim 23 recites, “the device of claim 21, wherein said movement area includes one or more channels on the support and connected to said main arm. This claim is indefinite for two reasons. First, it depends on claim 21 which has been

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canceled. Second, if the applicant intended that claim 23 depend on claim 22, it raises the obvious question, i.e., what is the difference between “the side arms” (claim 22) and “the channels” (claim 23).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Batchelder.

The channel structure recited in the claims reads on the device of Batchelder illustrated in figure 6A. Regarding the recitation in the claims that the electrodes are in contact with the fluid, Batchelder teaches [col. 4, lines 50-55]: “Note that FIGS. 2 and 2A include insulators placed between the electrodes and the mobile dielectric materials. These are not necessary if the conductivity of the dielectric media is low enough, and if there are no detrimental interactions between the electrode material and the dielectric media.”.

Response to Arguments

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Applicant's arguments filed 10 July 2003 have been fully considered but they are not persuasive.

Much of the applicant's arguments are directed to the physical mechanism by which the particles move in the apparatus (electrophoresis vs. dielectrophoresis). These arguments are not well-taken by since apparatus claims must distinguish over the art by recitations of structure.. While the intended use of the apparatus of Batchelder is to moving neutral particles by dielectrophoresis, it could be used for moving charged particles. It is well-known in the art that charged particles will experience movement in "dielectrophoretic" apparatus. For example, Sibalis teaches [col. 2, lines 63-65]: "...in an alternating electrostatic field, charged particles will always tend to move towards the electrode having the opposite polarity to its own net charge." Applicant's statement the "Batchelder fails to teach the electrodes making contact with the media". This argument is not well-taken for two reasons. First the "fluid medium" is not explicitly recited in the claims. Second, Batchelder does teach that the electrodes can be in contact with the fluid media. Specifically, Batchelder teaches [col. 4, lines 50-55]: "Note that FIGS. 2 and 2A include insulators placed between the electrodes and the mobile dielectric materials . These are not necessary if the conductivity of the dielectric media is low enough, and if there are no detrimental interactions between the electrode material and the dielectric media."

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Starsiak Jr. whose telephone number is (703) 308-1797. The examiner can normally be reached on Monday to Wednesday from 8:00 AM to 3:30 PM and on Thursday and Friday from 8:00 AM to 12:00 PM.

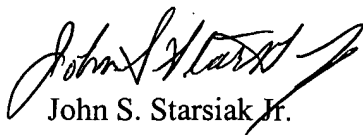
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700



John S. Starsiak Jr.

09 September 2003